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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,623	04/08/2004	Dennis R. Boulais	BSEN121510	8190

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EXAMINER
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KASZTEJNA, MATTHEW JOHN

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/820,623

Applicant(s)

BOULAIS, DENNIS R.

Examiner

Matthew J. Kasztejna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,7,9,12,21 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,9,12,21 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Notice of Amendment***

In response to the amendment filed on March 13, 2006, amended claims 1, 9 and 12; canceled claims 2, 5-6, 8, 10-11, 13-20 and 22-26; and new claim 27 are acknowledged. The following new and reiterated grounds of rejection are set forth:

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "120" has been used to designate both the "clamping mechanism" and the "engaging mechanism". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Furthermore, the drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "break-out box" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-4, 7, 9, 12, 21 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 1 and 27, it is unclear according to the specification and the drawings as to what comprises the

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fixed feature positioned along the shaft. Claims 3-4, 7, 9, 12 and 21 are necessarily rejected as being dependent upon rejected claim 1.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 7, 9 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication 2002/0133077 to Edwardsen et al.

**In regards to claim 1**, Edwardsen et al. disclose an operator control device for controlling an endoscope, the endoscope having an endoscope shaft, the operator control device comprising: one or more controls 214 for controlling the endoscope; a rotatable coupler 226 for rotatably securing the operator control device to the fixed feature 210 on the endoscope shaft, the rotatable coupler allowing a rotation of the operator control device with respect to the endoscope shaft but preventing movement along the length of the endoscope shaft (see Fig. 2 and paragraph 0030); a trigger component 810 for switching the operator control device between an engaged mode and a disengaged mode; and an anti-rotating component 830 for preventing the operator control device from rotating with respect to the endoscope shaft when the operator control device is in the engaged mode, the operator control device being allowed to rotate with respect to the endoscope shaft when the operator control device is in the disengaged mode wherein the operator control device can be detached from

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the endoscope shaft (see paragraphs 0022-0026 and 0033-0036). The apparatus of Edwardsen et al. is considered to be inherently capable of performing the recited method claims.

**In regards to claim 3**, Edwardsen et al. disclose an operator control device for controlling an endoscope, wherein the trigger component may be manually operated to switch between the engaged mode and the disengaged mode (see paragraph 0034). The apparatus of Edwardsen et al. is considered to be inherently capable of performing the recited method claim.

**In regards to claim 7**, Edwardsen et al. disclose an operator control device for controlling an endoscope, wherein the fixed feature on the endoscope shaft is a break-out box 210 (see Fig. 2).

**In regards to claim 9**, Edwardsen et al. disclose an operator control device for controlling an endoscope, wherein the collar is a rotating locking collar that is attached to the proximal end of the fixed feature on the endoscope shaft (see paragraph 0031-0032).

**In regards to claim 21**, Edwardsen et al. disclose an operator control device for controlling an endoscope, wherein the anti-rotating component comprises an anti-rotation pad 830 (see paragraph 0034).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent Application Publication 2002/0133077 to Edwardsen et al. in view of U.S. Patent No. 6,830,545 to Bendall.

**In regards to claim 4**, Edwardsen et al. disclose an operator control device for controlling an endoscope but are silent with respect to wherein the trigger component may be remotely operated to switch between the engaged mode and the disengaged mode. Bendall teaches of an analogous operator control device wherein a rear portion 16 contains a small radio transceiver 26 with an antenna 27 for wireless communication to a probe base station 29, and thus allowing for remote control of desired operator components. It would have been obvious to one skilled in the art at the time the invention was made to include a wireless connection in the apparatus of Edwardsen et al. in order to provide wireless control of desired actuators as taught by Bendall. The apparatus of Edwardsen et al. and Bendall is considered to be inherently capable of performing the recited method claims.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent Application Publication 2002/0133077 to Edwardsen et al. in view of U.S. Patent No. 6,805,664 to Doyle et al.

**In regards to claim 12**, Edwardsen et al. disclose an operator control device with an engaging component but are silent with respect to wherein the rotating component being a clutch mechanism. Doyle et al. teach of an analogous apparatus having a clutch 202 for adjusting the position of a device (see Col. 4, Lines 23-67). It

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would have been obvious to one skilled in the art to use a clutch means in the apparatus of Bendall in order to provide a means for rotationally positioning an instrument for surgery as taught by Doyle et al.

***Allowable Subject Matter***

Claim 27 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Response to Arguments***

Applicant's arguments filed March 13, 2006 have been fully considered but they are not persuasive.

Applicant states that Edwardsen et al. fails to disclose a device wherein the operator control device can be detached from the endoscope shaft. However, Edwardsen et al. teach that the control handle is assembled in such a fashion that it could be detached from the endoscope shaft (see paragraphs 0022-0026), as one would merely reverse the assembly process to take the apparatus apart for cleaning and/or parts replacement. Edwardsen et al. also teach that it is well known in the art to fasten an endoscope shaft to a control handle (see paragraph 0006), thus the shaft can be unfastened or detached from the handle. Furthermore, the words "can be" in the claim may be properly interpreted as "capable of," and "capable of" does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use.

Applicant states that Bendall fails to teach of remotely controlling the trigger mechanism for switching between the engaged or disengaged mode. However, Bendall



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clearly teaches of a device wherein a rear portion 16 contains a small radio transceiver 26 with an antenna 27 for wireless communication to a probe base station 29, and thus inherently allowing for remote control of any or all of the operator components (See Col. 2, Lines 15-53).

Applicant's arguments with respect to claim 2 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

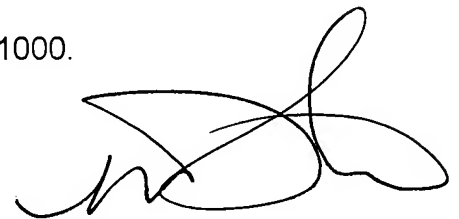
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK *mlk*

5/23/06



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